

REMARKS/ARGUMENTS

Claims 1-10 remain in this Application for consideration. In the Office Action of November 5, 2004, the examiner raised informality objections to the specification and claims of the present application. By the amendments submitted herewith, paragraph [0019] of the specification has been amended to adopt the examiner's suggested wording, as have claims 4, 6, and 8. Claim 1 has been amended to overcome the examiner's objection to the word "the" instead of "a" in line 4 of claim 1 by providing antecedent basis for "said total mass" in the preamble of the claim. Applicant notes that these objections are all minor in nature, were raised for the first time in the Office Action of November 5, 2004, and the amendments place the application in better condition for allowance or appeal. Thus, Applicant respectfully requests that these minor amendments be entered by the examiner.

Submitted herewith is a Notice of Appeal, along with the requisite fee, indicating Applicant's intention to appeal the examiner's current rejection to the Board of Patent Appeals and Interference in the event that the examiner maintains the rejection in view of the remarks presented herein.

Rejections Under 35 U.S.C. § 102

The examiner has maintained his rejection under 35 U.S.C. § 102(b) on the basis that the invention was in public use or on sale at Applicant's Web site more than one year prior to the filing date of the application. The rejection is based entirely on information the examiner gleaned from an archival Web site called "archive.org". The examiner further stated that the sworn declarations previously submitted by Applicant, proving that the cited information was not

in fact present at Applicant's Web site prior to the application date, were declarations "under 37 C.F.R. 1.131" which could not overcome a statutory bar under 35 U.S.C. § 102(b).

Applicant respectfully submits that the examiner has improperly characterized the previously submitted declarations. The declarations previously submitted are not declarations under 37 C.F.R. 1.131, which would be appropriate when "swearing behind" a cited reference to establish a prior invention date. The declarations establish, based on the sworn statements of employees of Applicant having first-hand knowledge of the Applicant's Web site content, that the information cited by the examiner from archive.org is incorrect. The sworn declarations further establish that the declarants contacted archive.org and were told that the information on archive.org with respect to Applicant's Web site was, in fact, incorrect. Applicant's declarations thus establish that the information upon which the examiner establishes the date of "public use or sale" on Applicant's Web site is not correct, thus the cited reference is not a valid reference, and the examiner's rejection under 35 U.S.C. §102(b) is improper.

The Board of Patent Appeals and Interferences has stated that *prima facie* evidence of a public use or sale under 35 U.S.C. §102(b) may be rebutted by convincing factual evidence to the contrary. See *Ex Parte Research & Mfg. Co., Inc.*, 10 USPQ2d 1657 (BPAI 1989) where a copyright registration held as prima facie evidence of publication date was refuted by letters and affidavits. Applicant submits that the examiner has erred in dismissing the sworn declarations submitted by Applicant as not presenting any "relevant proof" to substantiate the actual date the information was placed on the Web site.

Furthermore, the archive.org site itself makes absolutely no representations as to the accuracy of the information at the site. In fact, archive.org explicitly disclaims any representation that its archived information is accurate. Quoting from the archive.org terms of use, accessible from the home page of archive.org, (emphasis added):

Because the content of the Collections comes from around the world and from many different sectors, the Collections may contain information that might be deemed offensive, disturbing, pornographic, racist, sexist, bizarre, misleading, fraudulent, or otherwise objectionable. The Archive does not endorse or sponsor any content in the Collections, **nor does it guarantee or warrant that the content available in the Collections is accurate, complete, noninfringing, or legally accessible in your jurisdiction, and you agree that you are solely responsible for abiding by all laws and regulations that may be applicable to the viewing of the content.** In addition, the Collections are provided to you on an as-is and as-available basis. You agree that your use of the Site and the Collections is at your sole risk. **You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections,** that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. **We make no warranty of any kind, either express or implied.**

Thus, Applicant believes it is tenuous at best, if not improper, for the examiner to rely on information from the archive.org site when that information is not represented as being accurate. The examiner's continued reliance on the archive.org site is even more troubling in view of the sworn statements provided by Applicant that show the information the examiner is relying on is not correct.

Finally, in drafting this response, Applicant accessed the links to Applicant's supposedly archived Web site at the archive.org Web site link provided by the examiner in making his rejection. The links purport to take the user to an archived version of Applicant's Web site at

various points in time. Clicking on the various links provided unsettling results. Some links opened windows having what appeared to be partial archives of Applicant's Web site, with missing graphics and missing information. Many links opened windows with the message "NOT IN ARCHIVE". Most disturbing, many links, apparently unable to locate any archival information, appeared to redirect to Applicant's current Web site. Thus, clicking a dated link at the archive.org site opened a window that in fact displayed Applicant's present Web site.

The examiner claims that Applicant has not presented any "relevant proof" to substantiate the date the information was placed at Applicant's Web site. Applicant has provided sworn statements from persons with first-hand knowledge that the information cited by the examiner was not on Applicant's Web site on the date alleged by the examiner. Applicant has provided sworn statements that archive.org personnel have told Applicant that the archived information at archive.org, relating to Applicant's Web site, is inaccurate. Applicant has provided a disclaimer from the cited archive.org Web site in which archive.org explicitly makes no guarantee, warranty, or representation that the content available at the site is accurate or complete. And, finally, Applicant has accessed the archive.org site and found that in many cases the Applicant's current Web site is displayed after clicking on a link to a supposedly archived site.

Applicant submits that not only has Applicant provided "relevant proof" that the information cited by the examiner is inaccurate (it is nothing more than unsubstantiated hearsay), Applicant has provided overwhelming evidence that the information the examiner relies on is inaccurate. Thus, the examiner's rejection of claims 1-10 under 35 U.S.C. §102(b) is improper, and should be withdrawn.

Rejections Under 35 U.S.C. § 103

The examiner also rejected claims 1-10 under 35 U.S.C. § 103 as being obvious over the "Derby Flat Weights" at the Web site "www.scoutstuff.org."


The "Derby Flat Weights" shows a picture of a generally triangular weight, having horizontal and vertical score lines. The entire description of the weight is as follows:

"this 2.3 oz. triangular flat zinc weight is scored so sections may be broken off to gradually adjust weight downward. Predrilled holes make installation easy. Screws included."

Claims 1-10 of the present application are directed to a weight for placement on a model racing car that simulates the undercarriage of an automobile. There is absolutely no teaching, suggestion, or disclosure in the "Derby Flat Weights" reference of making the weight resemble an undercarriage of an automobile. As stated in MPEP §2143.01, the mere fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. The picture disclosed on the "Derby Flat Weights" reference is triangular shaped, with no suggestion of an automobile undercarriage. Likewise the written description makes no suggestion of such an undercarriage. There is absolutely no suggestion in the cited reference to modify the triangular weight to resemble an automobile undercarriage. Thus, since there is no suggestion in the reference to make the modification, the rejection of claims 1-10 is unsupported by the art and should be withdrawn.

In view of the above amendments and remarks, Applicant believes that claims 1-10 of the application are in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

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